

commission and credits the vendor with the sale. The vendor site ships the product.

The hub server dynamically creates HTML code and/or JavaScript needed to submit a purchase request if the user clicks on an icon/button. This HTML and JavaScript is dynamically inserted into the page with an <IFRAME>, JavaScript, or similar tag.

The invention has the advantage that it enables a sale to be completed without the buyer leaving the affiliate's site.

The invention has the advantage that a buyer need enter credit card and ship to data only once and can visit any Site in the affiliate network later without having to reenter the data, even though new products from new vendors may be subsequently featured on any site.

#### **Summary of Prior Art**

On the Internet, electronic transactions are processed at a vendor's server. A single vendor web site displays products of this one vendor. Buyer credit card or payment method and shipping information of one or more buyers, including a particular buyer, is stored at the vendor's server during the first purchase from the vendor's web site. When a purchase request of the particular buyer is received at the vendor server from the vendor's web site, the stored buyer credit and shipping information of the particular buyer is combined with product selection received from the vendor site resulting in combined purchase order information. The combined purchase order information is recorded at the vendor's server. The vendor's server bills the buyer's credit card. The vendor site ships the product. There is no provision for handling sales for multiple vendors that advertise products on affiliate web sites. If a buyer wishes to purchase a product advertised on a web site other than the vendor's site the buyer is transferred by a link to the vendor's site and all information must be re-entered into that vendor's server as described above.

#### **Detailed Description of the Prior Art**

Patent 5.960.411 ('411) provides a method and system for single-action ordering of items in a client/server environment, wherein the server is a vendor's server. The single-action ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and a server system. The server system assigns a unique client identifier to each client system. The server system also stores purchaser-specific order information for various potential purchasers. The purchaser-specific order information is collected from a previous order placed by the purchaser. The server system maps each client identifier to a purchaser that may use that client system (a browser) to place an order. A purchaser engages a client system to view a vendor's web page wherein vendor's products are

displayed. When a purchaser wants to place an order, the purchaser engages the client system to send the request for information describing the item to be ordered along with its client identifier. The server system sends the requested information (e.g., via a Web page) to the client computer system along with an indication of the single action to perform to place the order for the item. With single-action ordering, the purchaser need only perform a single action (e.g., click a mouse button) to order the item. When the purchaser performs that single action, this causes the client system to notify the server system. The server system then completes the order by adding the purchaser-specific order information (i.e. credit card, ship to address, etc.) for the purchaser that is mapped to that client identifier to the item order information (e.g., product identifier and quantity). Thus, once the description of an item is displayed on the client, the purchaser need only take a single action to place the order to purchase that item. Also, since the client identifier identifies purchaser-specific order information already stored at the server system, there is no need for such sensitive information to be transmitted via the Internet or other communications medium. The server (vendor) ships the product and bills the purchaser's credit card.

#### **Success**

The Success method is described as placing an image of a gift box (an icon) on each affiliate's web site. When a visitor clicks on the icon a free gift is awarded. In return information is solicited from the visitor. The article is silent as to making purchases. No purchase is involved. The gifts are free.

#### **Kenshav**

Discloses several types of hub topologies single ring, dual ring, token bus and hub or star ring. Any of these are suitable as a hub server in applicant's invention. The reference is silent as to making purchases. No purchase is involved.

#### **Castro**

Castro discloses HTML building blocks for web pages. The reference is silent as to making purchases. No purchase is involved.

### **Argument for Patentability**

Applicant provides a method and system for single-action ordering of items in a client/hub server/affiliates/vendors environment, wherein the hub server stands between the client and multiple vendor's and products that are displayed on an affiliate's web page. The single-action ordering system reduces the number of purchaser interactions needed to place orders from multiple affiliates and eliminates sensitive information that would be transmitted between a client system and the server systems of multiple vendors if existing systems were employed. As in '411 the hub server system

assigns a unique client identifier to each client system. The hub server system also stores purchaser-specific order information for various potential purchasers. The purchaser-specific order information is collected from a previous order placed by a purchaser. The hub server system maps each client identifier to a purchaser that may use that client system to place an order. A purchaser employs a client system (a browser) to view an affiliate's web page wherein, unlike '411, different vendor's products are displayed. In '411 only the orders for the one vendor can be processed, and only at the vendor's web site.

In applicant's invention, when a purchaser wants to place an order, the purchaser employs the client system to send the request for information describing the item to be ordered along with its client identifier to the hub server. In '411 the request is sent to the vendor's server. The hub server sends the requested information (e.g., via a Web page) to the client computer system along with an indication of the single action to perform to place the order for the item. With single-action ordering, the purchaser need only perform a single action (e.g., click a mouse button) to order the item. When the purchaser performs that single action, this causes the client system to notify the hub server system. The hub server system then completes the order by adding the purchaser-specific order information (i.e. ship to address, etc.) for the purchaser that is mapped to that client identifier to the item order information (e.g., product identifier and quantity). The hub server forwards item order information to the vendor who ships the product. In '411 the vendor server and hub server are one and the same so multiple vendors cannot be accommodated. In '411, the web site operator stores credit card numbers whereas in applicant's invention only the hub server has it, minimizing potential misuse of sensitive financial information.

Once the description of an item is displayed on the client, the purchaser need only take a single action to place the order to purchase that item regardless of which one of many vendors provides the item. Also, since the client identifier identifies purchaser-specific order information already stored at the hub server system, there is no need for such sensitive information to be transmitted via the Internet or other communications medium to the vendor. The vendor ships the product and the hub server bills the purchaser's credit card, credits the appropriate vendor with the sale and credits the affiliate with a commission. '411 has no mechanism to handle multiple affiliates and multiple vendors.

Thus it is apparent that the prior art does not provide a mechanism or method wherein multiple vendors can display their wares on affiliate web site(s) and receive orders for items and a ship to address (via the hub server) without dealing with sensitive credit card information. One instance only of sensitive credit card information is maintained at one hub server, not multiple vendor servers. In the prior art, multiple servers, maintained by multiple vendors maintain multiple instances of sensitive credit card information. Applicant's invention eliminates this by providing a central source of credit

card information, bills the buyer for a purchase, credits the affiliate with a commission for the sale and credits the vendor for the sale.

Neither Success, Keshav, nor Castro disclose or suggest applicant's invention, either taken alone or in combination.

Applicant respectfully traverses the use of "official notice" throughout the Office Action as the rationale supporting the obviousness rejection. Applicant is not aware of any prior art in e-commerce or retail that provides a method wherein multiple vendors can display their wares on an affiliate web site and receive orders for items and a ship to address (via a hub server) without dealing with sensitive credit card information.

#### **Group I Claim Rejections - 35 USC § 103**

I. Examiner has rejected claims 1, 2, 7, 8, 13, 14, 18, 22, 23, 25 and 27-29 under 35 U.S.C. 103(a) as being unpatentable over Success in view of Keshav.

For the reasons set forth more fully below, in is respectfully submitted that Success and Keshav are inappropriate references for combining.

Examiner states that it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teaching of Success with Keshav's hub server for faster access from multiple sources. The result that applicant is after is not "faster access from multiple sources". Applicant's invention is a method wherein multiple vendors can display their wares on one or more affiliate web sites and receive orders for items and a ship to address (via the hub server) without having to deal with sensitive credit card information. While faster access may be an admirable by product, it is the elimination of multiple instances of sensitive credit card information that is at the essence of applicant's invention. Security on the Internet is a well-known and long-standing problem.

Examiner states that Success:

"fails to teach the feature of conditional combining buyer information with product selection"

and that

"Official notice is taken that this feature is old and well known in the e-commerce art and / or retail art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of maintaining centralized customer records."

Applicant respectfully traverses the use of "official notice" here and elsewhere in the Office Action because neither Success, Keshav or '411 disclose or suggest forwarding combined purchase order information from a hub server to a vendor because none of the references contemplate the combination of a hub server communicating with multiple affiliates and multiple vendors.

None of the references disclose or suggest applicant's claimed invention because none disclose or suggest necessary elements of the claimed combination. None of the references disclose or suggest combining stored buyer information with product selection from an affiliate and forwarding the combined purchase order information from said hub server to a vendor. The distinguishing language in the claims is as follows:

Claims 1 and 18:

Combining stored buyer information of said particular buyer with product selection from one of said affiliate sites upon a condition that a purchase request of said particular buyer is received, resulting in combined purchase order information being sent to the hub server; and,

Forwarding said combined purchase order information from said hub server to a vendor.

Claims 7 and 13:

Combining stored buyer billing and shipping information of said particular buyer with product selection received from one of said affiliate sites upon a condition that a purchase request of said particular buyer is received, resulting in combined purchase order information;

Recording said combined purchase order information at said hub server; and,

Forwarding said combined purchase order information from said hub server to a vendor.

The dependent claims are subject to the same limitations and arguments.

The Examiner has applied the references to separate elements of the combination rather than to the combination viewed as a whole. 35 USC 103 requires that "the subject matter as a whole" be considered in determining what would have been obvious.

None of the references suggest combining the references in the manner that the Examiner has. The Examiner cites Success as a primary reference to teach all of the limitations except: Success does not teach "a hub server", for which Examiner cites Keshav.

The Examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of centralized networking system in the form of a hub topology for faster access from multiple sources

All that Keshav teaches on this point is that a ring topology can take many different forms all suitable for the claimed hub server. The Examiner does not point out where in the references it is suggested that such a combination is possible or even desirable.

The Examiner has failed to set forth a prima facie case of obviousness for rejections combining references under 35 USC 103 (obviousness). The MPEP at 706.02 (j) sets forth a process by which a rejection under 35 USC 103 is to be sustained wherein, as in the present case, a single reference (Success) is modified by combining it with one or more references (Keshav):

The MPEP states that to establish a prima facie case of obviousness three basic criteria must be met:

- (1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.
- (2) There must be some reasonable expectation of success.
- (3) The references when combined must teach or suggest all the claim limitations.

In these remarks, the three criteria are set forth in order to show why the references cannot be properly combined:

- (1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

The claims were rejected as being unpatentable over Success in view of Keshav. Success is the primary reference relied upon, and is the "reference" referred to in Step 1. Success is the reference to be modified.

The Examiner proposes that it would be obvious to modify the applied reference (Success) to use the elements of Keshav to provide the claimed electronic commerce method. The Examiner has failed to point out why the modification that he proposes would be obvious.

Applicant's invention is a combination and the crucial suggestion or motivation step in determining obviousness must be considered. The Examiner has failed to do this. Neither Success nor Keshav contain anything to suggest the desirability of applicant's claimed combination or any motivation to modify the method of Success to effectuate a multiple e-commerce transaction. In order to satisfy this requirement, the Examiner must show that at least one of the references suggests that it is possible or desirable to modify the applied reference to effectuate a multiple e-commerce transaction. The Success method is described as placing an image of a gift box (an icon) on each affiliates web site. When a visitor clicks on the icon a free gift is awarded. In return information is solicited from the

visitor. The article is silent as to making purchases. No purchase is involved; the gifts are free.

(2) There must be some reasonable expectation of success.

There is no reasonable expectation of success in combining the references in the manner that the Examiner suggests because there is no provision for multiple affiliates and multiple vendors.

(3) the references when combined must teach or suggest all the claim limitations.

The references do not teach combining stored buyer information with product selection from an affiliate site upon a condition that a purchase request of a particular buyer is received, resulting in combined purchase order information being sent to the hub server which forwards it to a vendor.

#### **Group II Claim Rejections - 35 USC § 103**

Group II. Examiner has rejected claims 3-6,9-12,15-17,19-21,24 and 26 under 35 U.S.C. 103(a) as being unpatentable over Success in view of Keshav and further in view of Castro.

Claims 3-6,9-12,15-17, 24 and 26 are independent claims that depend from parent claims in Group I discussed above. These claims are patentable for the reasons stated under Group I.

Claim 19 is an independent claim and claims 20-21 are dependent thereon. For the reasons set forth more fully below, applicant respectfully submits that Success, Keshav, and Castro are inappropriate references for combining.

None of the patents disclose or suggest applicant's claimed invention because none disclose or suggest necessary elements of the claimed combination. None of the references disclose or suggest combining stored buyer information with product selection from an affiliate and forwarding the combined purchase order information from a hub server to a vendor. The distinguishing language in the claims is as follows:

Claims 19-21:

C. Receiving at said hub server, a cookie, said cookie identifying a prospective buyer, said affiliate site, said product and optionally said vendor site;

D. Dynamically creating a <FORM> including all information necessary to effect a purchase transaction;

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F. Forwarding a purchase request for said product to be shipped to said buyer to a vendor upon a condition that said <FORM> is submitted to said hub server.

The Examiner has applied the references to separate elements of the combination rather than to the combination viewed as a whole. 35 USC 103 requires that "the subject matter as a whole" be considered in determining what would have been obvious.

None of the references suggest combining the references in the manner that the Examiner has. The Examiner cites Success as a primary reference to teach all of the limitations except: Success does not teach "a hub server".

All that Keshav teaches is that a ring topology can take many different forms all suitable for the claimed hub server. Keshav does not suggest the combination.

All that Castro teaches is a number of separate HTML building blocks that can be used to implement Internet features. Castro does not suggest the combination.

The Examiner does not point out where in any of the references it is suggested that such a combination is possible or even desirable.

The Examiner has failed to set forth a prima facie case of obviousness for rejections combining references under 35 USC 103 (obviousness). The MPEP at 706.02 (j) sets forth a process by which a rejection under 35 USC 103 is to be sustained wherein, as in the present case, a single reference (Success) is modified by combining it with one or more references (Keshav and Castro):

The MPEP states that to establish a prima facie case of obviousness three basic criteria must be met:

(1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

(2) There must be some reasonable expectation of success.

(3) The references when combined must teach or suggest all the claim limitations.

In these remarks, the three criteria are set forth in order to show why the references cannot



be properly combined:

(1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

The claims were rejected as being unpatentable over Success in view of Keshay. Success is the primary reference relied upon, and is the "reference" referred to in Step 1. Success is the reference to be modified.

The Examiner proposes that it would be obvious to modify the applied reference (Success) to use the elements of Keshay and Castro to provide the claimed electronic commerce method. The Examiner has failed to point out why the modification that he proposes would be obvious.

Applicant's invention is a combination and the crucial suggestion or motivation step in determining obviousness must be considered. The Examiner has failed to do this. Neither Success, Keshay nor Castro contain anything to suggest the desirability of applicant's claimed combination or any motivation to modify the method of Success to effectuate a multiple e-commerce transaction. In order to satisfy this requirement, the Examiner must show that at least one of the references suggests that it is possible or desirable to modify the applied reference to effectuate a multiple e-commerce transaction. The Success method is described as placing an image of a gift box (an icon) on each affiliates web site. When a visitor clicks on the icon a free gift is awarded. In return information is solicited from the visitor. The article is silent as to making purchases. No purchase is involved; the gifts are free.

(2) There must be some reasonable expectation of success.

There is no reasonable expectation of success in combining the references in the manner that the Examiner suggests because there is no provision for multiple affiliates and multiple vendors.

(3) The references when combined must teach or suggest all the claim limitations.

The references do not teach dynamically creating a <FORM> including all information necessary to effect a purchase transaction and forwarding a purchase request for said product to be shipped to said buyer to a vendor upon a condition that said <FORM> is submitted to said hub server by a user.

In view of the above arguments for patentability, reexamination of claims 1-29 pending in this application and allowance thereof is respectfully requested.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on 1/25/02

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